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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,825	08/17/2000	Danuvio Carrion	05725.0346-1	2723

7590

08/04/2003

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EXAMINER

HOWARD, SHARON LEE

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 08/04/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/582,825

Applicant(s)

CARRION ET AL.

Examiner

Sharon L. Howard

Art Unit

1615

-- The MAILING DATE of this c mmunicati n appears on the c ver sheet with the c rrespondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2003 .
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_ .

In view of the re-evaluation of the Pappas reference, prosecution will be continued for examination on the present application. Please note that Pappas discloses particles (at col.13, lines 27-53) which are present in the composition.

Claims 1-24 are pending.

### **DETAILED ACTION**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14,20,21,23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Pappas (U.S. Patent No. 5,093,108).

Pappas teaches a quick drying nail enamel composition and a method for coating the nails, thereby achieving favorable properties such as gloss and durability (see abstract). Pappas teaches that the nail enamel composition primary film forming polymers (e.g. nitrocellulose, cellulose acetate, ethyl cellulose, vinyl polymers, acrylate type polymers) and a secondary or additional film forming polymers comprising alkyd resins and acrylic and methacrylic resins (col.9, lines 13-68). Pappas teaches compositions which may be used as base coats or top coats for application to the nails (col.9, lines 6-8). Pappas also teaches a plasticizer (col.10, lines 1-33), a thixotropic agent (col.13, lines 30-42), coloring agents or pigments (col.12, lines 65-68) consisting of D & C red No. 7, titanium dioxide, yellow and red iron oxides, chromide oxide greens

Art Unit: 1615

(col.13, lines 1-13). Pappas teaches that the pigments comprise 2% to about 5% of pigment particles (col.13, lines 48-53). Pappas teaches that the particles are milled to about 5 microns (col.13, lines 42-45). Pappas also teaches solvents, such as ethyl and methyl acetate, pentane, hexane and methylene chloride (col.10, lines 10-31), which reads on a cosmetically acceptable medium.

The prior art meets the claims of the instant application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14,20,21,23,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pappas ('108).

Pappas is discussed above.

Pappas does not particularly teach microspheres.

However, although Pappas does not particularly teach microspheres, Pappas suggest the teachings of microspheres. Pappas teaches pigment particles which are milled to about 5 microns (col.13, lines 42-45).

The expected result would be a nail enamel composition comprising pigment particles, a film forming polymer, in a cosmetically acceptable.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Pappas. One having ordinary skill in the art

Art Unit: 1615

would have been motivated to prepare the composition of Pappas, because Pappas teaches a composition which is useful for the purpose of coating the nails.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pappas ('108) in view of Ellingson et al. (U.S. Patent No. 5,965,111).

Pappas is applied above.

Pappas does not specifically teach applying a nail enamel top coat.

However, Ellingson teaches fast drying nail polish compositions which are known in the art for having improved wear properties (see abstract). Ellingson teaches a method of applying a basecoat to the nails (col.6, lines 65-67, bridging col.7, lines 1-13) and a method of applying a topcoat (col.8, lines 33-48). Ellingson teaches that the topcoat compositions comprises pigments and dyes (col.9, lines 30-33). Ellingson also teaches film forming polymers (col.8, lines 49-67, col.9, lines 13) and solvents (col.9, lines 14-19) which read on a cosmetically acceptable medium.

The expected result would be a quick drying nail enamel composition comprising in a cosmetically acceptable medium, pigment particles, a film forming polymer, as well as other conventional ingredients which are known in nail enamel compositions.

It would have been within the skill of the ordinary practitioner at the time the invention was made to use the composition taught by Pappas, because Pappas teaches a quick drying nail enamel composition comprising film forming polymers, pigment particles, and solvents, in the composition taught by Ellingson, with expectation of achieving a nail enamel composition comprising a solvent, pigment particles and a film former polymer.

Claims 15-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellingson ('111) in combination with Schlossman (U.S. Patent No. 5,356,617).

Ellingson is applied above.

Ellingson does not teach microspheres.

However, Schlossman teaches pigment-material-microsphere complexes which are known in nail enamels (see abstract). Schlossman teaches both organic and inorganic microspheres which can be hollow, solid or porous or mixtures thereof (col.6, lines 65-67). Schlossman teaches that the microspherical powders are known to have diameters from 1 to 100 microns (col.6, lines 66-68, col.7, lines 1-8)

The expected result would be a fast drying nail polish composition comprising a base coat composition, a topcoat, as well as film forming polymers, a solvent and microspheres.

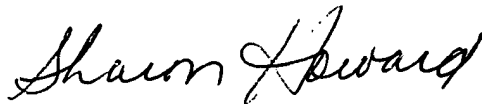
It would have been within the skill of the ordinary practitioner at the time the time the invention was made to use the fast drying nail polish composition taught by Ellingson, in the composition taught by Schlossman, because Schlossman teaches microspheres which are known in nail enamels and one would expect similar results.

Art Unit: 1615

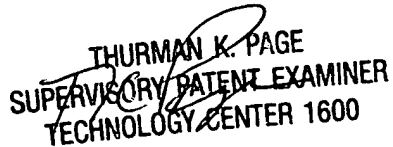
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (703) 308-4359. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3121 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Sharon Howard  
July 31, 2003



THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600